

## REMARKS

Claims 19-35 (formerly presented as 29-45) are pending in this application. Claims 20-25, 27-30 and 32-35 were amended to correct informalities in the claim numbering..

Claims 19, 22, 26, 29, 31 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weaver, Jr. et al.* (U.S. Patent 5,475,870) in view of *Ozaki* (U.S. Patent 5,933,465). Applicant respectfully traverses these rejections, because the cited reference, alone or in combination, do not disclose or suggest features of the present invention as described in independent claims 19, 26 and 31. Claims 20-21, 23-25, 27-28, 30, 32-33 and 35 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Specifically, *Weaver* does not disclose a “second base station based on a second transmission method” as recited in independent claims 19, 26, and 31. Instead, *Weaver* only discloses different command types (e.g., transmit power, system control commands) being used under one transmission method (TDMA/CDMA – see col. 1, lines 15-39; col. 5, lines 16-36; col. 6, lines 64-67).

Additionally, the *Ozaki* reference does not cure the deficiencies of *Weaver*. *Ozaki* does not disclose the feature of “inserting interruption phases having an effective total duration of a maximum of 10 observation frames” as recited in claim 19, and similarly recited in claims 26 and 31. While *Ozaki* generally discloses GSM transmission, *Ozaki* does not teach to insert interruption phases having an effective total duration of a maximum of 10 observation frames. In contrast, *Ozaki* merely discloses sending frequency correction channel (FCCH) control signals every 10 frames (col. 1, lines 56-67).

Furthermore, the teaching in *Weaver* makes it improper to combine with the teaching in *Ozaki* to arrive at the obviousness conclusion stated by the Examiner. While obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, there also must be a *teaching, suggestion or motivation* to do so (see MPEP 2141). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983) (MPEP 2141.02). And the mere fact that references can be combined

or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01). The Applicant's claims should not be used as a roadmap for the Examiner to formulate obviousness rejections based on hindsight.

Notwithstanding the fact that *Weaver* did not teach the aforementioned limitation, there is no reason to modify the teaching in *Weaver* in the manner suggested by the Examiner. *Weaver* teaches a method and apparatus for adding and removing base stations from a communication system using attenuation levels (col. 5, lines 9-12; 38-65). *Weaver* teaches that handoffs may be effectively executed by balancing reverse link handoff boundaries to the forward link handoff boundary and vice versa (col. 10, lines 14-24). *Ozaki*, on the other hand, makes no mention of such handoffs, and instead discusses control signal detection in GSM systems. Accordingly, there is no teaching, motivation or suggestion (other than to improperly glean knowledge from the Applicants' disclosure) to modify the reference to teach a "second base station operating on a GSM standard which is based on a synchronization frame structure having a period of 51 frames; and inserting interruption phases having an effective total duration of a maximum of 10 observation frames."

In light of the above, Applicant respectfully submits that claims 19-35 are now in condition for allowance, which is respectfully requested. A petition for a one-month extension of time has been submitted with this response, along with a check in the amount of \$110. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-0205) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Peter Zura

Reg. No. 48,196

Bell, Boyd & Lloyd LLC

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4208

Dated: June 1, 2004